

REMARKS

In the Office Action, the Examiner indicated that claims 1 through 37 are pending in the application and the Examiner rejected all claims.

Rejection of Claims 1-37 under 35 U.S.C. §103(a)

On page 2 of the Office Action, the Examiner rejected claims 1, 6, 7, 14, 19, 20, 27, 32-34 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,960,411 to Hartman et al. ("Hartman") in view of U.S. Patent No. 6,029,141 to Bezos et al. ("Bezos").

On page 5 of the Office Action, the Examiner rejected claims 2,3,4,5,10-13, 15-18, 23-26, 28-31 and 35-37 under 35 U.S.C. 103(a) as being unpatentable over Hartman in view of Bezos, further in view of Official Notice.

Claims 8, 9, 21, 22

Applicant notes that no basis for rejection is given for claims 8, 9, 21, 22. Since claims 8, 9, 21, and 22 depend from a rejected base claim, while its status as being rejected is clear, it is still unclear whether or not claims 8, 9, 21 and 22 would be allowable if rewritten in independent form. The Examiner is respectfully requested to clarify the status of claims 8, 9, 21 and 22.

The Present Invention

The present invention provides a method and system "for providing online comparison shopping, from among two or more vendors" (claim 1). The claimed system is a front-end

ordering system for two or more vendors. This ordering system allows a customer to purchase a list of items from one or more of the vendors supported by the system. The goal of the present invention is to place an optimal or near-optimal order by ordering each item from a specific vendor of the system. By utilizing comparison shopping, the user receives the best available products matching the set criteria, with the possibility that each product is from a different vendor selected from all available vendors.

Particularly, the system of the present invention compiles a shopping list for the user which identifies specific items that the user wishes to purchase. Then the system allows the user to specify certain optimization criteria (shopping criteria) for obtaining an optimal shopping order based on the user's shopping list. Based on the user-specified optimization criteria and any optimization criteria pre-set by the system, the system optimizes the user's shopping list to produce an optimal shopping order from among the multiple vendors. The user is able to modify the generated optimal shopping order to reflect any last minute changes by the user. If the user approves the optimal shopping order, the shopping order is processed according to known techniques.

U.S. Patent No. 5,960,411 to Hartman et al.

U.S. Patent No. 5,960,411 to Hartman et al. ("Hartman") teaches a method and system for placing an order to purchase an item via the Internet. Rather than identifying an optimal shopping order from a shopping list, involving multiple vendors, Hartman teaches the optimization of shipping from a single vendor. A portion of Hartman relied upon by the Examiner, column 5,

lines 27-55, illustrates a situation wherein a customer makes a first purchase from vendor A, and then makes a second purchase from vendor A. If both items are available, or available within a predetermined time period (e.g., if item A is available in two days, and item B is available in three days), then the system of Hartman will optimize the shipping by delaying the shipping of item A until item B is also available, and then ship the two together. This can result in reduced shipping costs for the consumer.

U.S. Patent No. 6,029,141 to Bezos et al.

U.S. Patent No. 6,029,141 to Bezos et al. ("Bezos") teaches an Internet based referral system that enables individuals and other "associates" to market products sold from a merchant's Web Site. The associates are paid a commission by the merchant for all products sold on the merchant's Web Site. The system includes automated registration software that associates can access through the merchant's site for setting up individual products for retail sale. The associate can set up hypertextual catalog documents that includes referral links. These links can allow a customer to link to the merchant's site and purchase a product. By selecting the referral link, a customer's computer transmits a unique ID of the selected product and of the associate selling the product to the merchant's site, which allows the merchant to identify the product and associate. If the customer subsequently purchases the product the account of the referring associate is credited.

The merchant site also allows the customer to select products from multiple different Web sites, and then perform a single "check out" from the merchant's site.

The Examiner has not Established a *prima facie* Case of Obviousness

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

MPEP 2143

As noted above, the present invention provides the ability to comparison shop from among two or more vendors using a single website. A shopping list of goods is compiled, and then optimization criteria are specified by the user. The offerings of the multiple vendors are then compared to the shopping list and, based on the optimization criteria, vendors are selected from among the multiple vendors to fulfill the order. Claim 1 states:

“A method for providing online comparison shopping, from among two or more vendors, by a website system”

Each additional independent claim (claims 14 and 27) states a form of this limitation in the preamble.

The Examiner acknowledges the prior art fails to teach comparison shopping. The Examiner notes this limitation appears in the preamble of the claims only. Additionally, the Examiner cites the following passage from the MPEP: “*A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.*” However, this portion of the MPEP does not apply to the independent claims in the present application. The

individual limitations cannot stand alone without the added limitations contained in the preamble. The individual limitations recited in each independent claim reference the two or more vendors contained in the preamble of the claim.

The MPEP, section 2111.02 cites: *“If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.”* Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Additionally, the MPEP also cites: *“Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.”* Both of these citations apply to the present case, as the preambles of the independent claims specifically state “comparison shopping” and “from two or more vendors”, each of which further limit the claims, as well as introduce terminology that limits the structure of the claimed invention.

As acknowledged by the Examiner, Hartman fails to teach comparison shopping. Bezos presents an Internet based merchant site where multiple vendors may advertise items for sale, allowing a consumer to purchase items from multiple vendors. However, Bezos fails to disclose or even remotely suggest comparison shopping. Bezos is primarily concerned with collecting a maximum amount of commission from a maximum amount of vendors marketed on a single web site. Bezos does not, though, provide a means for comparing products between vendors. Additionally, no combination of the teachings of Hartman and Bezos discloses this limitation. Since Hartman and Bezos lacks any teaching or suggestion, either individually or in combination,

of optimization based on the offerings of specific items by at least two or more vendors, as claimed in each independent claim, all of the claims including claims 1, 6, 7, 14, 19, 20, 27, and 32-34 specifically rejected by the Examiner patentably define over Hartman in view of Bezos. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 6, 7, 14, 19, 20, 27, and 32-34 under 35 U.S.C. 103.

The Applicant refers the Examiner to previous Responses for detailed examples pointing out the benefits of the present invention, the problems that it solves, and why Hartman does not teach or reasonably suggest optimizing a shopping list based on optimization criteria to produce an optimal shopping order.

Regarding the Examiner's rejections of claims 2, 3, 4, 5, 10-13, 15-18, 23-26, 28-31, and 35-37 under 35 U.S.C. 103 as being unpatentable over Hartman in view of Bezos, further in view of Official Notice, applicant submits that the "official notice" taken by the Examiner does not teach or suggest a system or technique whereby the offerings of multiple vendors are analyzed to see if they can fulfill an optimal shopping list, based upon optimization criteria provided by the customer, and provides no suggestion to modify Hartman in view of Bezos to achieve such a system or technique. Accordingly, for the reason set forth above, claims 2, 3, 4, 5, 10-13, 15-18, 23-26, 28-31, and 35-37 patentably define over Hartman in view of Bezos in further view of the Official Notice taken by the Examiner, either alone or in any combination. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections under 35 U.S.C. 103 to claims 2, 3, 4, 5, 10-13, 15-18, 23-26, 28-31 and 35-37.


Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 09-0461.

Respectfully submitted

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Date



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